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APPLICATION NO. 3	FILING DATE/94	KRAUS FIRST NAMED INVENTOR	W	ATTORNEY DOCKET NO.
				TRW21364

QMS1/1002  
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EXAMINER
JOYCE, R

ART UNIT	PAPER NUMBER
3744	

DATE MAILED: 10/02/98

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

08/230,083

Applicant(s)

Willibald Kraus

Examiner

H. Joyce

Group Art Unit

3744



☒ Responsive to communication(s) filed on Jul 12, 1996

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three (3) month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-14 and 16 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☒ Claim(s) 1-13 is/are allowed.

☒ Claim(s) 14 and 16 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

### **DETAILED ACTION**

1. The indicated allowability of claims 14 and 16 is withdrawn in view of the "Recapture Rule".

#### ***Recapture Issues and Rejection***

2. During the prosecution of S.N. 07/642,475, which matured into U.S. Patent No. 5,105,731 claims 1, 3-5 and 7-11 were rejected under 35 USC 103 as being unpatentable over either Feles et al. or Frien in view of Mizusawa, but claims 2 and 12-14 were only objected to and were indicated to be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claim.

In response to that rejection, applicant filed an amendment in which claims 2 and 12 were canceled and were rewritten in independent form and the statement was made that "the claims as now presented were patentable over all of the prior art of record."

Thus, the prosecution history of U.S. Patent No. 5, 105,731 clearly reveals that applicant surrendered a claim having the scope of claim 1 in an attempt to obtain allowance of the original patent claims. In particular, applicant added the limitations contained in originally presented claim 2 to obtain allowance of his application.

The specific limitations which were added to claim 1 to obtain an allowable claim were:

wherein the inner frame (4) has a surrounding rim (7) carrying rib members (8) spaced transversely with stays (9) extending therefrom and a surrounding frame (1) joining the stays (9).

In this reissue application, applicant has presented claims 14 and 16, none of which recites the limitations added to obtain allowance of the patent.

Each of these claims must be addressed to determine if it violates the recapture doctrine.

Claim 14's scope differs from that of originally filed claim 1 by specifying that there are two clip connections, one of which comprises a springy tongue and is spaced from the surrounding wall, and the other of which comprises a springy tongue which is integral with the surrounding wall. Here, the change in scope, even though narrower than the originally filed claim 1, is merely an obvious duplication of parts which is an unpatentable limitation. Therefore, it does violate the recapture rule. In this regard, see In re Clement, 45 USPQ2d 1161, 1165 (Fed. Cir. 1997).

Claim 16 adds no limitations to what was recited in originally filed claim 1; and thus, clearly violates the recapture doctrine.

Claims 14 and 16 are rejected under the equitable "recapture" doctrine which prevents a reissue applicant from obtaining subject matter surrendered in an attempt to obtain allowance of the original patent claims. See, in this regard, In re Clement, 45 USPQ2d 1161, 1164 (Fed. Cir. 1997).

#### *Allowable Subject Matter*

3. Claims 1-13 are allowed.


Serial Number: 08/230,083  
Art Unit: 3404

Page 4

***Reissue Applications***

This reissue application was filed without the required offer to surrender the original patent or, if the original is lost or inaccessible, an affidavit or declaration to that effect. The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to H. Joyce whose telephone number is 703/308/0274 and whose Group fax number is 703/305/3463.

  
**HAROLD JOYCE  
PRIMARY EXAMINER  
ART UNIT 3404**

HJ  
June 26, 1998